

REMARKS

By this Office Action, the Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

Group I. Claims 1-17 drawn to a method of treating cardiac disease in a mammal, a method of modulating myocyte apoptosis in a mammal, a method of reducing the risk of cardiomyopathy or cardiac dysfunction and a method of cardioprotection in a mammal, comprising the administering of an effective amount of a compound or agent that blocks or otherwise inhibits Mst1 or Mst1 pathway classified in class 512, subclass 12.

Group II. Claims 18-21, drawn to a method of screening for compounds that modulate cardiac myocyte apoptosis, classified in class 435, subclass 7.1.

Group III. Claims 22-27, drawn to a composition for modulating cardiac myocyte apoptosis comprising an Mst1 inhibitor, classified in class 530, subclass 350.

Group IV. Claims 28-29, drawn to an assay for screening of potential compounds or agents effective to modulate Mst1 activity, classified in class 435, subclass 7.1.

Group V. Claims 30-31, drawn to a method of treating or ameliorating cardiac disease in a mammal comprising administering to said mammal a nucleic acid or vector, classified in class 514, subclass 44.

Group VI. Claims 32-33, drawn to an animal model of cardiac disease comprising a transgenic animal, classified in class 800, subclass 3.

Responsive to the Requirement for restriction, Applicants elect to prosecute the invention of Group I, with traverse, Claims 1-17, which are drawn to a method of treating cardiac disease in a mammal, a method of modulating myocyte apoptosis in a mammal, a method of reducing the risk of cardiomyopathy or cardiac dysfunction and a method of cardioprotection in a mammal, comprising the administering of an effective amount of a compound or agent that blocks or otherwise inhibits Mst1 or Mst1 pathway classified in class 512, subclass 12.

Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define compositions and methods, with properties so distinct as to warrant separate Examination and Search. Claims 1-17 of Group I are drawn to methods of treating cardiac disease, modulating myocyte apoptosis, reducing risk of cardiomyopathy or cardiac dysfunction, comprising administering an MST1 and MST1 pathway inhibitor that are fundamentally related to Claims 18-21 of Group II, drawn to a method of screening for compounds that modulate cardiac myocyte apoptosis, classified in class 435, subclass 7.1. The search for any of the methods separately classified by the Examiner as the invention of Group II would require an additional search of the

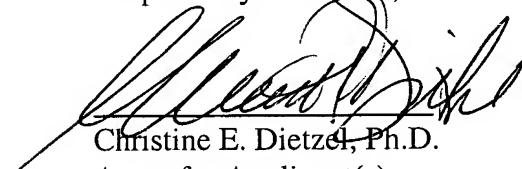
identical classes wherein the method of Group I are classified, thus resulting in a duplicate search for the same material. Thus, Applicants submit that the Search and Examination of the entire Application, or, at least, of Group I with Group II can be made without serious burden, and therefore request that the Examiner examine the claims of Groups I and II of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group I and Group II is in order.

No fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In view of the above, withdrawal of the Requirement for the Restriction is requested, and an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,



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